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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,754	12/21/2000	Barry M. Verdegan	4191-00043	1068

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EXAMINER

REIFSNYDER, DAVID A

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 07/30/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/745,754

Applicant(s)

VERDEGAN ET AL.

Examiner

David A Reifsnyder

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____ .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-19,89-91 and 94-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9,89-91 and 94-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-9, 13-19; 89, 91, 94, 95, 98 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purvey in view of Holm et al.

Regarding claims 7-9, 13-19; 89, 91, 94, 95, 98 and 99; Purvey discloses a filtering system for filtering working fluid from a machine comprising a filter (13) having a filter media element having a plurality of filters (20) for filtering said working fluid; said filter having an inlet receiving working fluid from said machine, a first outlet returning working fluid to said machine, a second outlet exhausting said cleaning fluid; said filter media element having a clean side communicating with said first outlet, and a dirty side communicating with said first inlet and second outlet; said filter having a filtering mode of operation and a backwash mode of operation; (see column 4, lines 18-42) and a centrifugal separator (25) having an inlet connected to said second outlet of said filter, said centrifugal separator (25) having a batch processing mode operative during said backwashing mode operative during said backwashing mode of said filter and receiving said contaminant-laden working fluid from said second outlet of said filter and separating and storing contaminant, said centrifugal separator comprising a housing having a rotor driven to rotate about an axis by a supply of pressurized air from a source of compressed air to the rotor (see column 9, lines 6-11) the pressurized air from a source of compressed air inherently or at least obviously including a valve for controlling the supply of pressurized air from the source of compressed air to the rotor; said rotor having an inner cylindrical sidewall with a hollow interior, and an outer cylindrical sidewall spaced radially outwardly of said inner cylindrical sidewall and defining an annular space therebetween, said inner cylindrical sidewall having a transfer passage

therethrough providing communication of said hollow interior with said annular space, said housing having an inlet for admitting contaminated-laden fluid to said hollow interior of said inner cylindrical sidewall for passing through said transfer passage into said annular space for centrifugal separation upon said rotation, said annular space providing a storage container storing said contaminant, a standpipe circumscribing said inner cylindrical sidewall and dividing said annular space into an inner annular chamber between said standpipe and said inner cylindrical sidewall, and an outer annular chamber between said standpipe and said outer cylindrical sidewall.

Regarding claims 7-9, 13-19; 89, 91, 94, 95, 98 and 99; Purvey discloses a filtering system as discussed above but fails to disclose that his filter (13) is the same type and includes all of the elements as the applicant's instantly claimed backwashable filter (16). The applicant states on page 4, line 10 to 11 that Holm et al. discloses a filter (102) which is like his claimed backwashable filter (16). It is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention to have replaced Purvey's filter (13) with Holm et al.'s filter (102) since Purvey and Holm et al both disclose filters for removing solids from liquids followed by cleaning their filters by backwashing them. Furthermore, the filtering system as suggested by Purvey in view of Holm et al. includes a valve for controlling a supply of pressurized air from a source of compressed air to the second inlet of the filter, and the centrifugal separator includes a valve for controlling a supply of pressurized air from a source of compressed air to their rotor. It is considered that since the filter and rotor both require compressed air, that it would have been obvious to one having ordinary skill in the art at the time of

Art Unit: 1723

the filtering system as suggested by Purvey et al. in view of Holm's to have used the same source of compressed air to supply pressurized air to both said rotor and said filter to provide the motive force for said rotor and said cleaning fluid for said filter.

Lastly, when replacing Holm et al.'s filter (102) for Purvey's filter (13) it is noted that the suggested filtering system of Purvey in view of Holm et al. would not include a plurality of filters as required by claims 18 and 19. It is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention to have duplicated Holm et al.'s filter (102) to create a plurality of filters to better filter the working fluid in the filtering system as suggested by Purvey in view of Holm et al. Furthermore, has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 10-12, 90 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purvey in view of Holm et al. further in view of Miller et al.

Regarding claims 10-12, 90 and 97; Purvey in view of Holm et al. suggests a filtering system as discussed above but fails to teach or fairly suggest that the storage container portion of their centrifugal separator includes a filter matrix (i.e. claim 10), the filter matrix having at least a 75% (i.e. claims 11, 23 and 90) and the filter matrix having at least a 95%. (i.e. claim 12)

Regarding claim 10-12, 90 and 97; Miller discloses a centrifugal separator including a storage container portion the storage container portion including a cellular filter matrix (54) for retaining solids, the higher the void volume of Miller's cellular filter

Art Unit: 1723

matrix (54) the better it would retain solids. Therefore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention for Miller's filter matrix to have a void volume of at least 95%.

Regarding claims 10-12, 90 and 97; it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention to have added the filter matrix (54) as taught by Miller in the storage container portion of Purvey in view of Holm's centrifugal separator to better retain solids in Purvey in view of Holm's storage container portion of their centrifugal separator.

Claim 96 is rejected under 35 U.S.C. 103(a) as being unpatentable over Purvey in Holm et al. further in view of May.

Regarding claim 96; Purvey in view of Holm et al. suggests a filtering system as discussed above but fails to teach or fairly suggest that their rotor include a turbine.

Regarding claim 96; May discloses a centrifugal filter which is rotated by a source of air impinging on a turbine, the air inherently or at least obviously being pressurized. (see column 1, lines 59-64)

Regarding claim 96; it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention to have used a turbine to rotate Purvey in view of Holm et al.'s rotor as taught by May since Purvey in view of Holm et al.'s rotor is rotated by impinging a fluid (e.g. gas) on some part of the rotor and May teaches that a turbine is well suited for that purpose.

Response to Arguments

Applicant's arguments filed June 4, 2003 have been fully considered but except for the 102(b) anticipation by Purvey and the 103 (a) obviousness over Purvey in view of Miller and Purvey in view of May they are not persuasive.

Most of the applicant's arguments are directed at the anticipation rejection of Purvey. Furthermore, if some of the arguments are meant to be directed to the obviousness rejections of Purvey in view of Holm et al. and Purvey in view of Holm et al. further in view of Miller, those arguments only argue why certain elements are not in Purvey or if those elements are not in Purvey why it would not have been obvious to one having ordinary skill in the art at the time of the invention to have added those elements to Purvey. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The only argument that argues an obviousness rejection of Purvey in view of Holm et al. relates to claims 16-19 and can be found on page 16, line 12 to page 17, line 12 of the applicant's remarks filed on April 21, 2003. The applicant argues on page 16, lines 23-25 that the attempt to combine Holm et al. with Purvey would be contrary to the teachings of Purvey because Purvey requires that the backflushing pressure be applied by backflushing working fluid from first outlet 18 to second outlet 24. This argument is not persuasive because when replacing Purvey's filter with Holm et al.'s filter there would not even be a first outlet 18, and while what the applicant's

Art Unit: 1723

representative calls a second outlet 24 would still be there, the second outlet 24 is actually a rejection conduit 24. The true second outlet of Purvey's filter would not be there because Purvey's filter has been replaced with Holm et al.'s filter. When replacing Purvey's filter with Holm et al.'s filter; Purvey's pump means (12) is in fluid communication with Holm et al.'s first inlet (114), Purvey's utilization means (14) is in fluid communication with Holm et al.'s first outlet (116), and Purvey's rejection conduit (24) is in fluid communication with Holm et al.'s second outlet (122). Lastly, the backwashing means is the backwashing means of Holm et al., which comprises a second inlet (118) in fluid communication with a source of cleaning fluid (120).

Final Rejection

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

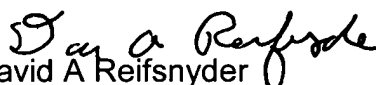
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Reifsnyder whose telephone number is 1-703-308-0456. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda M Walker can be reached on 1-703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9310 for regular communications and 1-703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1-703-308-3601.


David A Reifsnyder
Primary Examiner
Art Unit 1723

DAR
July 28, 2003